

REMARKS

This paper is in Response to the Office Action dated March 19, 2004, which Office Action indicated that the prior response, filed November 5, 2003, was "not fully responsive" to the office action of May 9, 2003. This Response, therefore, provides a Supplemental response to that First Response of November 5, 2003. The present, Second Response has been written to substitute for the November response. The Office Action dated May 9, 2003 rejected Claims 1-23 (all pending claims of the application) variously under 35 U.S.C. § 102 and 103.

Regarding Information Disclosure Statements

Applicant attaches hereto a copy of the Form PTO 1449 which accompanied Applicant's Information Disclosure Statement filed on March 26, 2001. This 1449 form consists of 8 pages. Applicant has only received page 1 of this PTO 1449, initialed by the Examiner, with the pending Office Action. Therefore, to complete the record Applicant respectfully requests that the Examiner indicate that he has considered all of the references on all eight (8) pages of the 1449 of March 26, 2001 by initialing each reference on each page of a copy of subject 1449, and returning it to the undersigned for our files. This will be greatly appreciated.

Regarding the Specification

Applicant has hereby amended the Abstract in compliance with the Office Action.

Regarding Claims 1-10

Claims 1-10 are canceled hereby, while traversing the grounds for rejection. That is, while Applicant has cancelled Claims 1-10, Applicant does not agree with the grounds for rejections stated in the Office Action and the Applicant does not concede that the stated grounds for rejection, including but not limited to the interpretation of the stated references and/or for the application of that art to Claims 1-10, are valid or appropriate. Applicant reserves the right to dispute and argue against the same or similar rejections in this or any application before the U.S. Patent and Trademark Office and/or in a court of law.

Regarding Claim 11

Claim 11 has been rejected under 35 U.S.C. § 102(b) as being anticipated by Pasonen. The Office Action states that "*Pasonen... teaches a system, comprising a fax-to-email network including at least a sender side at which an image on paper is received by the network and a receiver side from which an email message is accessible to an email user, and a bifurcated interface at the sender side (Fig. 1; 3, Lines 10-30). Note that in the reference, there at least exists an interface for the entry of documents and an interface for the selection of a destination.*" Without conceding that the characterization of Pasonen as stated in the Office Action is accurate or valid, Applicant has nonetheless cancelled Claim 11, without prejudice, reserving Applicant's right to pursue this or similar claims and to challenge the characterization in this or other proceedings before the USPTO and any court of law.

Regarding Claims 12-23; Rejections under 35 USC 103

Claims 12-23 were rejected in the Office Action under 35 U.S.C. 103(a) as being unpatentable over Pasonen in view of Grob et al. Applicant addresses each of those rejections below.

Regarding Independent Claim 12

In making the §103 rejection of Claim 12, the Office Action appears to rely on the same characterization of Pasonen as stated in connection with Claim 11, but further states that Pasonen teaches a "*bifurcated interface including a host portion, the host portion being connected to the fax function (figure. 1; column 3, Lines 10-30).*" However, while the Office Action directs Applicant to Fig. 1 and Column 3, Lines 10-30, there is no helpful hint given by the Office Action as to what is understood by the Examiner to be a "host portion." Having not identified the "host portion," the Office Action proceeds to concede that Pasonen "*fails to disclose a traveler portion selectively communicating with the host portion, the traveler portion being portable.*" The Office Action then utilizes the reference of Grob et al. to provide the missing limitation of the "traveler portion." The Office Action refers to Grob et al. Column 2, Lines 1-2, and Column 4, Lines 15-21, as teaching "*a traveler portion selectively communicating with a host portion, the traveler portion being "portable."*" Unfortunately, in this entire combination of references, the Office Action has not provided any identification of what constitutes the

“bifurcated interface” of Pasonen, nor what constitutes the “host portion” of Pasonen, nor what constitutes the “traveler portion” and corresponding “host portion” of Grob. The simple fact that Grob has a device which is portable (perhaps referring to the radio telephone 260), does not prove that Grob et al. teaches the traveler/portable portion as claimed in Claim 12. The Office Action states that Pasonen (in connection with Claim 11) provides a bifurcated interface, but implies that such interface is in the form of one interface for the entry of documents and a second interface for the selection of a destination. Assuming, without agreement, that this identification of two “interfaces” established the bifurcated interface of Pasonen, Applicant submits that Grob et al. does not teach that either one of these two functions is **portable** while the other one of these two functions remains “**connected to said fax function**” (as required by Claim 12 of the present application). As best Applicant can understand from the statements of the Office Action, the traveler/portable portion which is asserted to have been provided by Grob et al. is that personal digital assistant mentioned in Column 4, Lines 18-21: “*Another embodiment uses a subset of the computer such as a personal digital assistant also having a facsimile adapter and/or facsimile software.*” Thus, this personal data assistant of Grob et al. is, itself, the fax function and, does not expressly or impliedly function as the traveler/portable portion of Claim 12. In Claim 12, the host portion is connected to the fax function while the claimed traveler/portable portion is “portable” relative to the fax function. Therefore, Grob et al. fails to supply the missing “**traveler portion being portable**” which the Office Action admits as being absent from Pasonen. Furthermore, the Office Action fails to express a teaching or combination of references to teach such a “**traveler portion selectively communicating with the host portion ... connected to [the] fax function**,” which the Office Action admits is absent from Pasonen.¹

¹ It should not be interpreted hereby that a PDA which has “facsimile software” or a “facsimile adapter” installed on it can not be the traveler portion of the present invention, or even that it can not be, alternatively, the fax function of the present invention (if properly functioning according to the claims). However, the personal digital assistant of Grob et al does not exhibit the features of the PDA or of the fax function according to, for example, Claim 12. Grob et al and the combination of Grob et al and Pasonen simply do not teach or render obvious the claimed limitations.

Based on the above, it is seen that an attempted combination of Pasonen and Grob et al., even assuming that it is proper and appropriate to combine these references (which is not admitted) does not and will not teach the invention as claimed in Claim 12. Thus, it is submitted that Claim 12 is not taught or rendered obvious by the suggested combination of Pasonen and Grob et al, nor by any other known references or combinations thereof.

Regarding Dependent Claims 13-15

Dependent Claims 13-15 are allowable at least because they are dependent from an allowable base claim, but also because they include additional limitations which further distinguish over the references.

Regarding Claims 16-23

Claims 16-23 were also rejected under 35 U.S.C. § 103 as being unpatentable over Pasonen in view of Grob et al.

Regarding Independent Claim 16

The Office Action admits that Pasonen “fails to disclose means wherein the fax machine interfaces with a personal data assistant” but states that Grob et al. discloses *a system for interaction with a fax machine and sending fax to email communications wherein the fax machine interfaces with a personal data assistant* (Fig. 1; Col. 2, Lines 1-2; Col. 4, Lines 15-21)”. Applicant contends, however, that Claim 16 does not state that the a fax machine “interfaces” with a personal data assistant. Claim 16 relates specifically to a method engaged in by a fax enabled device and a separate personal data assistant, wherein an image from the hard copy is transmitted **from the fax enabled device to a destination entered at the separate personal data assistant**. Claim 16 has been amended to make this more clear. It can be seen that the combination of Pasonen and Grob et al. will not result in the claimed invention and, therefore, does not and cannot render Claim 16 obvious.

Based on the above, it is seen that an attempted combination of Pasonen and Grob et al., even assuming that it is proper and appropriate to combine these references (which is not admitted) does not and will not teach the invention as claimed in Claim 16. Thus, it is submitted that Claim 16 is not taught or rendered obvious by the suggested combination of Pasonen and Grob et al, nor by any other known references or combinations thereof.

Regarding Dependent Claims 17 - 23

Dependent Claims 13-15 are allowable at least because they are dependent from an allowable base claim, but also because they include additional limitations which further distinguish over the references.

Regarding New Claims 24- 69

These new claims 24- 69 are submitted as distinguishing over the cited references of Pasonen and Grab et al, and also as distinguishing over all other known art. Applicant points out at least the following distinctions by which the new claims 24-69 are rendered patentable over all known prior art. Applicant submits that the stated distinctions are not the only patentable distinctions of the referenced claims, that the emphasizing (such as underlining or *italics*) of certain terms does not imply that other terms of the claims are less distinguishing, and, further, that the pointing out of more (in number) distinguishing limitations in one claim than in another does not imply that other distinctions and reasons for patentability do not exist for the respective claims.

Regarding Independent Claim 24

It is submitted that at least the combination of the receiving step and (first) conveying step distinguishes over the prior art. That is, none of the art teaches or renders obvious, especially in combination with the other limitations of the claim, receiving a destination address at a personal data assistant and conveying that address from the personal data assistant to a host interface portion via a data exchange independent of other data exchanges described in the claim;

and, further, the art does not teach conveying that address previously characterized "together with commands instructing the host interface portion to initiate a facsimile delivery."

Regarding Independent Claim 27

It is submitted that at least the combination of the receiving step and (first) conveying step distinguishes over the prior art. That is, none of the art teaches or renders obvious, especially in combination with the other limitations of the claim, receiving an alphanumeric email address, being the address of a mailbox on a computer network, at a personal data assistant and conveying that address from the personal data assistant to a host interface portion via a data exchange independent of other data exchanges described in the claim; and, further, the art does not teach conveying that address previously characterized "together with commands instructing the host interface portion to initiate a facsimile delivery."

Regarding Independent Claim 32

It is submitted that at least the combination of the transmitting step and creating step distinguishes over the prior art. That is, none of the art teaches or renders obvious, especially in combination with the other limitations of the claim, transmitting custom text along with a destination address, both entered at a personal data assistant, and creating at a remote server an email message containing an image conveyed from a fax device and the custom text.

Regarding Independent Claim 33

It is submitted that at least the combination of the determining step and prompting step distinguishes over the prior art. That is, none of the art teaches or renders obvious, especially in combination with the other limitations of the claim, determining at a host interface portion which of a plurality of destination addresses, entered at a remote traveler interface portion and communicated to the host interface portion, is an email address and which is a telephone address, and prompting by the host interface portion for placement of related hardcopy documents at a fax function.

Regarding Dependent Claims 25, 26, 28-31, and 34-69

Dependent Claims 25, 26, 28-31, and 34-69 are allowable at least because they are dependent from an allowable base claim, but also because they include additional limitations which further distinguish over the references.

CONCLUSION

In light of the above arguments and remarks, Applicant submits that it is clearly shown that there is no *prima facie* case of obviousness established in the Office Action and the now pending Claims 12-23 are patentable in spite of all of the known prior art. Applicant does not imply by its arguments herein, nor does Applicant admit, that these presented arguments are the only reasons for allowability of the claims or that there are not other ways by which the claims distinguish over the references and all known prior art and combinations thereof.

Additional Claims 24-69 have been added by this response, and, upon reading the remarks and arguments stated above, these new claims will also be seen to be patentable over all of the known references and combinations thereof.

Applicant respectfully requests favorable consideration of all claims 12-69 and an early indication of allowance. Applicant welcomes a telephone call to the undersigned attorney if such a call might assist with resolving issues and moving this case to allowance.

The undersigned cordially requests the Examiner to call to discuss any items that might be helpful in moving this case to allowance.

Respectfully submitted,



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Date: March 31, 2004

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Docket No.: **E035 1140**